

REMARKS

AMENDMENTS TO THE SPECIFICATION

5 Page 10 has been further amended in the way suggested by the Examiner.

AMENDMENTS TO THE CLAIMS

 New claims 64-66 have been added. Basis for claim 64 is on page 11, lines 9-13.
10 Basis for claim 65 is on page 11, line 17. Basis for claim 66 is on page 11, lines 14-15.

 It is submitted that new claims 64-66 can properly be added, even if the finality of
the office action is maintained, since these claims are directed to specific embodiments
of the cosmetic compositions claimed in claim 1, and thus do not raise any new issues
15 for consideration by the Examiner.

THE OBJECTIONS AND REJECTIONS

The Objection under 35 U.S.C. 132.

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 The objection under 35 U.S.C. 132 has been rendered moot by the amendment
to the specification.

The Provisional Double Patenting Rejection

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 Applicants will address the issues raised by the provisional double patenting
rejection when the claims of this application and Application Serial No. 09/398,377 are
otherwise in condition for allowance.

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The Rejections under 35 U.S.C. 102 and 35 U.S.C. 103

Applicants respectfully traverse

(1) the rejection of claims 1-5 , 9-12, 20, 37, 38, 62 and 63 under 35 U.S.C. 102 as anticipated by Mueller (U.S. Patent No. 5,281,329) with Morawsky (U.S. Patent No. 5,736,125) as a teaching reference, and

(2) the rejection of claims 1-6, 9-12, 20, 37-38, 62 and 63 under 35 U.S.C. 103 as unpatentable over Mueller in view of Morawsky,

insofar as those rejections can be understood, for the following reasons.

Initially it is noted that claim 6, which has been rejected under 35 U.S.C. 103. requires the presence of hydroxyl groups in the SCC polymer (as further specified in the claims). There is nothing in Mueller to suggest the use of hydroxyl-containing SCC polymers, and the Office Action says nothing about this difference. It seems possible, therefore, that the rejection of Claim 6 under 35 U.S.C. 103 is the result of a clerical error.

The Rejection under 35 U.S.C. 102

Applicants traverse the rejection under 35 USC 102 for the reasons which are set out in full in the Reply mailed June 17, 2003, and which, in the interests of brevity, are incorporated herein by reference rather than repeated verbatim. In addition, the Examiner's attention is drawn to the attached Declaration by Dr. Bitler. This Declaration affirms the following propositions which have been previously set out, and which are believed to be apparent from the papers previously of record;--

- (a) the procedures set out in Mueller will make the petroleum oils flow more easily, i.e. will make the oils thinner, not thicker; and
- (b) Mueller does not disclose or suggest any cosmetic composition;
- (c) the SCC polymers used as additives by Mueller do not contain carboxyl groups;

(d) the SCC polymers used as additives in Morawsky must contain carboxyl groups; and

(e) one of ordinary skill in the art of cosmetic compositions, reading Morawsky, would understand that the numerical range of 0.1-12% disclosed by Morawsky is a range within which effective concentrations are likely to be found; that concentrations within the range of 0.1-12% will not necessarily be effective; and that, in some cases, effective concentrations will be outside the range of 0.1-12%; and

(f) the amounts of additive likely to be used in practicing Mueller's invention are much smaller than the amounts likely to be used in practicing Morawsky's invention or in practicing the present invention.

Dr. Bitler's declaration also explains that it seems likely, in view of (f), that at least some SCC polymers will both (i) make at least some oils thinner when used in low concentrations, and (ii) make at least some oils thicker when used in much greater concentrations. Insofar as the Examiner's rejections depend upon the overlap of the broadest ranges disclosed in Mueller and Morawsky, Dr. Bitler's explanation may assist the Examiner in understanding the technical reasons for the fact, already established by the documents themselves, that Mueller and Morawsky are intended to produce, and do in fact produce, opposite results.

Newly added claims 64-66 add greater specificity to one of the distinguishing features of claim 1, namely that it is restricted to cosmetic compositions.

The Rejections under 35 U.S.C. 103

Applicants traverse the rejections under 35 USC 103 for the reasons which are set out in full in the Reply mailed June 17, 2003, and which, in the interests of brevity, are incorporated herein by reference rather than repeated verbatim. In addition, the Examiner's attention is drawn to the attached Declaration by Dr. Bitler, which is relevant for the same reasons as are explained above in connection with the rejection under 35 USC 102.

Newly added claims 64-66 add greater specificity to one of the distinguishing features of claim 1, namely that it is restricted to cosmetic compositions.

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Previously-Filed Petition To Add Additional Priority Claim

10 It is noted that no response has yet been received to the previously-filed (mailed October 25, 2001) Petition to add an additional priority claim, and the associated Request for Decision on Previously-Filed Petition, and for Corrected Filing Receipt filed with the Reply mailed June 17, 2003. The Examiner is asked to take the appropriate action to resolve these outstanding matters.

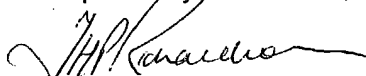
CONCLUSION

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It is believed that this application is now in condition for allowance, and such action at an early date is earnestly requested. If, however, there are any outstanding issues that could usefully be discussed by telephone, the Examiner is asked to call the undersigned.

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Respectfully submitted,



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